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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/752,968 | 01/02/2001 | Peter Rae Shintani | SNY-P4164 | 1765 |

24337 7590 01/26/2005

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| EXAMINER | |
|---|---|
| SHELEHEDA, JAMES R | |
| **ART UNIT** | **PAPER NUMBER** |
| 2614 | |

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/752,968 | SHINTANI ET AL. | |
| | Examiner | Art Unit | |
| | James Sheleheda | 2614 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *18 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-15,17-36 and 38-81* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15,17-36 and 38-81* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-15, 17-25, 27-36, 38-51, 53-57 and 59-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (Zigmond) (6,698,020) in view of Swix et al. (6,718,551).

As to claims 1 and 53, Zigmond discloses a method of playback of stored entertainment content (Fig. 1), comprising:

wherein the stored entertainment content is stored at a content storage device at a user site that is remotely situated from the service provider (playback from storage or a videotape at the user site; column 14, lines 1-12);

receiving an advertisement from an advertising server of the service provider (column 14, lines 66-67 and column 15, lines 1-16); and

at the user site (Fig. 5; column 10, lines 16-34), merging the advertisement with the stored entertainment content so that both the advertisement and the stored entertainment content are played back (column 15, lines 52-65).

While Zigmond discloses inserting new advertisements into stored entertainment content upon user initiation of playback, he fails to specifically disclose notifying a service provider and receiving an advertisement in response to said notifying.

In an analogous art, Swix discloses a television distribution system (Fig. 1) wherein a users set top box will notify the headend upon user selection of content (column 9, lines 25-31 and column 10, lines 7-19) which requires targeted advertisements (column 9, lines 25-31) and will transmit the advertisement in response to the notifying (column 9, lines 25-31) based a user profile (column 7, lines 31-42) for the typical benefit of receiving updated relevant advertisements as needed (column 9, lines 25-31).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond's system to include notifying a service provider and receiving an advertisement in response to said notifying, as taught by Swix, for the typical benefit of only providing updated relevant advertisements to a subscriber when required.

As to claims 2 and 54, Zigmond and Swix disclose wherein merging the advertisement with the stored entertainment content comprises inserting the advertisement in place of a stored advertisement forming a part of the entertainment content (updating obsolete ads; see Zigmond at column 14, lines 1-12).

As to claims 3 and 55, Zigmond and Swix disclose wherein the inserting takes place during real-time playback of the entertainment content (wherein all inserting takes place during real-time viewing and trigger detection; see Zigmond at column 15, lines 49-65).

As to claims 4 and 56, Zigmond and Swix disclose wherein merging the advertisement with the stored entertainment content comprises inserting the advertisement at a location of an advertisement place holder forming a part of the content (at a triggering signal occurring in the program; see Zigmond at column 15, lines 49-65).

As to claims 5 and 57, Zigmond and Swix disclose wherein the inserting takes place during real-time playback of the entertainment content (wherein all inserting takes place during real-time viewing and trigger detection; see Zigmond at column 15, lines 49-65).

As to claim 6, while Zigmond and Swix disclose storing entertainment content in a storage medium, they fail to specifically disclose the storage device forming a part of a television receiver device.

The examiner takes official notice that it was notoriously well known in the art at the time of invention by applicant to provide a storage medium inside a television

receiver, such as a set top box, for the typical benefit of simplifying the system through the use of a single device for both receiving and storing entertainment content.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond and Swix's system to include the storage device forming a part of a television receiver device for the typical benefit of simplifying the system through the use of a single device for both receiving and storing entertainment content.

As to claim 7, while Zigmond and Swix disclose storing entertainment content in a storage medium, they fail to specifically disclose storing the content in a set top box.

The examiner takes official notice that it was notoriously well known in the art at the time of invention by applicant to provide a storage medium inside a television receiver, such as a set top box, for the typical benefit of simplifying the system through the use of a single device for both receiving and storing entertainment content.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond and Swix's system to include storing the content in a set top box for the typical benefit of simplifying the system through the use of a single device for both receiving and storing entertainment content.

As to claim 8, Zigmond and Swix disclose wherein the entertainment content is stored in a storage device coupled to the set top box (storage medium providing recorded content to the set top for ad insertion; see Zigmond at column 14, lines 1-12).

As to claims 9 and 58, Zigmond and Swix disclose transmitting a viewing history to the service provider prior to receiving the advertisement (see Swix at column 7, lines 7-11).

As to claims 10 and 59, Zigmond discloses a method of playback of stored entertainment content (Fig. 1), comprising:

wherein the stored entertainment content is stored at a content storage device at a user site that is remotely situated from the service provider (playback from storage or a videotape at the user site; column 14, lines 1-12);

selecting an advertisement (using ad selection rules; column 11, lines 35-49);

transmitting the advertisment from the service provider to the set-top box (column 14, lines 66-67 and column 15, lines 1-16) to be merged with the entertainment content (column 15, lines 52-65) at the set-top box (Fig. 5; column 10, lines 16-34).

While Zigmond discloses inserting new advertisements into stored entertainment content upon user initiation of playback, he fails to specifically disclose receiving a message indicating playback and selecting an advertisement based on a user profile.

In an analogous art, Swix discloses a television distribution system (Fig. 1) wherein a users set top box will notify the headend upon user selection of content (column 9, lines 25-31 and column 10, lines 7-19) which requires targeted advertisements (column 9, lines 25-31) and will transmit the advertisement in response to the notifying (column 9, lines 25-31) based a user profile (column 7, lines 31-42) for

the typical benefit of receiving updated relevant advertisements as needed (column 9, lines 25-31).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond's system to include a message indicating playback and selecting an advertisement based on a user profile, as taught by Swix, for the typical benefit of only providing updated relevant advertisements to a subscriber when required.

As to claims 11 and 60, Zigmond and Swix disclose wherein merging the advertisement with the stored entertainment content (updating obsolete ads; see Zigmond at column 14, lines 1-12).

As to claims 12 and 61, Zigmond and Swix disclose wherein merging the advertisement with the stored entertainment content comprises inserting the advertisement in place of a stored advertisement forming a part of the entertainment content (updating obsolete ads; see Zigmond at column 14, lines 1-12).

As to claims 13 and 62, Zigmond and Swix disclose wherein the inserting takes place during real-time playback of the entertainment content (wherein all inserting takes place during real-time viewing and trigger detection; see Zigmond at column 15, lines 49-65).

As to claims 14 and 63, Zigmond and Swix disclose wherein merging the advertisement with the stored entertainment content comprises inserting the advertisement at a location of an advertisement place holder forming a part of the content (at a triggering signal occurring in the program; see Zigmond at column 15, lines 49-65).

As to claims 15 and 64, Zigmond and Swix disclose wherein the inserting takes place during real-time playback of the entertainment content (wherein all inserting takes place during real-time viewing and trigger detection; see Zigmond at column 15, lines 49-65).

As to claim 17, while Zigmond and Swix disclose storing entertainment content in a storage medium, they fail to specifically disclose storing the content in a set top box.

The examiner takes official notice that it was notoriously well known in the art at the time of invention by applicant to provide a storage medium inside a television receiver, such as a set top box, for the typical benefit of simplifying the system through the use of a single device for both receiving and storing entertainment content.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond and Swix's system to include storing the content in a set top box for the typical benefit of simplifying the system through the use of a single device for both receiving and storing entertainment content.

As to claim 18, Zigmond and Swix disclose wherein the entertainment content is stored in a storage device coupled to the set top box (storage medium providing recorded content to the set top for ad insertion; see Zigmond at column 14, lines 1-12).

As to claim 19, Zigmond and Swix disclose receiving a viewing history to the service provider prior to receiving the advertisement (see Swix at column 7, lines 7-11).

As to claims 20 and 65, Zigmond and Swix disclose wherein the selecting further comprises selecting the advertisement based upon information relating to the stored entertainment content being played back (see Zigmond at column 12, lines 44-51).

As to claims 21 and 66, Zigmond and Swix disclose wherein the selecting further comprises selecting the advertisement based upon a playback time (wherein time and date of playback would determine if an ad is expired; column 14, lines 1-9).

As to claims 22 and 67, Zigmond and Swix disclose wherein the selecting further comprises selecting the advertisement based upon a playback date (wherein time and date of playback would determine if an ad is expired; column 14, lines 1-9).

As to claims 23 and 68, Zigmond and Swix disclose wherein the selecting further comprises selecting the advertisement based upon information relating to a viewing

history of a user (subscriber viewing selections; see Swix at column 7, lines 31-42 and column 8, lines 4-13).

As to claim 24, Zigmond and Swix disclose wherein the viewing history is transmitted from the set top box to a service provider (see Swix at column 7, lines 7-11).

As to claims 25 and 69, Zigmond and Swix disclose wherein the selecting further comprises selecting the advertisement based upon information relating to an advertising history for the user (see Zigmond at column 13, lines 40-47).

As to claim 27, Zigmond discloses a set top box (Fig. 5; column 10, lines 16-35), comprising:

an input interface receiving a signal indicating that a user has initiated a playback of stored entertainment content (wherein some interface must be present to allow user initiation of playback; column 14, lines 1-12), wherein the stored entertainment is stored at a content storage device at a user site that is remotely situated from the service provider (playback from storage or a videotape at the user site; column 14, lines 1-12);

means for receiving a selected advertisement from the service provider (column 14, lines 66-67 and column 15, lines 1-16); and

a programmed processor situated at the user site (present to control the system; column 10, lines 16-35) that merges the selected advertisement with the entertainment

content so that the entertainment content is played back with the selected advertisement (column 14, lines 1-12 and column 15, lines 49-65).

While Zigmond discloses playback of stored content, he fails to specifically disclose a mean for notifying a service provider of the initiation of the playback of content.

In an analogous art, Swix discloses a television distribution system (Fig. 1) wherein a users set top box will notify the headend upon user selection of content (column 9, lines 25-31 and column 10, lines 7-19) which requires targeted advertisements (column 9, lines 25-31) and will transmit the advertisement in response to the notifying (column 9, lines 25-31) based a user profile (column 7, lines 31-42) for the typical benefit of receiving updated relevant advertisements as needed (column 9, lines 25-31).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond's system to include a message indicating playback and selecting an advertisement based on a user profile, as taught by Swix, for the typical benefit of only providing updated relevant advertisements to a subscriber when required.

As to claim 28, Zigmond and Swix disclose wherein the programmed processor that merges the advertisement with the stored entertainment content comprises means for inserting the advertisement in place of a stored advertisement forming a part of the entertainment content (updating obsolete ads; see Zigmond at column 14, lines 1-12).

As to claim 29, Zigmond and Swix disclose wherein the means for inserting inserts the advertisment during real-time playback of the entertainment content (wherein all inserting takes place during real-time viewing and trigger detection; see Zigmond at column 15, lines 49-65).

As to claim 30, Zigmond and Swix disclose wherein the programmed processor that merges the advertisement with the stored entertainment content comprises means for inserting the advertisement at a location of an advertisement place holder forming a part of the content (at a triggering signal occurring in the program; see Zigmond at column 15, lines 49-65).

As to claim 31, Zigmond and Swix disclose wherein the means for inserting inserts the advertisement during real-time playback of the entertainment content (wherein all inserting takes place during real-time viewing and trigger detection; see Zigmond at column 15, lines 49-65).

As to claim 32, while Zigmond and Swix disclose storing entertainment content in a storage medium, they fail to specifically disclose the storage device forming a part of a television receiver device.

The examiner takes official notice that it was notoriously well known in the art at the time of invention by applicant to provide a storage medium inside a television

receiver, such as a set top box, for the typical benefit of simplifying the system through the use of a single device for both receiving and storing entertainment content.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond and Swix's system to include the storage device forming a part of a television receiver device for the typical benefit of simplifying the system through the use of a single device for both receiving and storing entertainment content.

As to claim 33, while Zigmond and Swix disclose storing entertainment content in a storage medium, they fail to specifically disclose wherein the storage device is a disc drive forming a part of the set top box.

The examiner takes official notice that it was notoriously well known in the art at the time of invention by applicant to provide a storage medium, such as a disc drive, inside a set top box for the typical benefit of simplifying the system through the use of a single device for receiving content and storing it on a portable medium.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond and Swix's system to include wherein the storage device is a disc drive forming a part of the set top box for the typical benefit of simplifying the system through the use of a single device for receiving content and storing it on a portable medium.

As to claim 34, Zigmond and Swix disclose wherein the entertainment content is stored in a storage device coupled to the set top box (storage medium providing recorded content to the set top for ad insertion; see Zigmond at column 14, lines 1-12).

As to claim 35, Zigmond and Swix further disclose means for transmitting a viewing history to the service provider prior to receiving the advertisement (see Swix at column 7, lines 7-11).

As to claim 36, Zigmond discloses a system for delivery of advertisements, comprising:

wherein the stored entertainment content is stored at a content storage device that is coupled to the set top box at a user site that is remotely situated from the service provider (playback from storage or a videotape at the user site; column 14, lines 1-12); and

means for transmitting an advertisement to the set top box (column 14, lines 66-67 and column 15, lines 1-16) for merged playback with the entertainment content (column 14, lines 1-12 and column 15, lines 49-65).

While Zigmond discloses selecting an advertisement for merging with locally stored content (using ad selection rules; column 11, lines 35-49), he fails to specifically disclose

means for receiving a message from a set top box indicative of a user's selection of playback of content;

a user profile server for storing a user profile of the user; and

an advertisement server, controlled by the service provider, receiving the user profile and supplying an advertisement selected in accordance with the profile.

In an analogous art, Swix discloses a television distribution system (Fig. 1) wherein a users set top box will notify the headend upon user selection of content (column 9, lines 25-31 and column 10, lines 7-19) which requires targeted advertisements (column 9, lines 25-31) and will transmit the advertisement from an ad server (file server, 102; column 7, lines 35-39) in response to the notifying (column 9, lines 25-31) based on a user profile stored in the headend (column 7, lines 7-11 and lines 31-42) for the typical benefit of receiving updated relevant advertisements as needed (column 9, lines 25-31).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond's system to include means for receiving a message from a set top box indicative of a user's selection of playback of content;

a user profile server for storing a user profile of the user; and

an advertisement server, controlled by the service provider, receiving the user profile and supplying an advertisement selected in accordance with the profile, as taught by Swix, for the typical benefit of only providing updated relevant advertisements to a subscriber when required.

As to claim 38, Zigmond and Swix disclose wherein the merging of the advertisement with the stored entertainment content is carried out by inserting the

advertisement in place of a stored advertisement forming a part of the entertainment content (updating obsolete ads; see Zigmond at column 14, lines 1-12).

As to claim 39, Zigmond and Swix disclose wherein the inserting takes place during real-time playback of the entertainment content (wherein all inserting takes place during real-time viewing and trigger detection; see Zigmond at column 15, lines 49-65).

As to claim 40, Zigmond and Swix disclose wherein the merging of the advertisement with the stored entertainment content is carried out by inserting the advertisement at a location of an advertisement place holder forming a part of the content (at a triggering signal occurring in the program; see Zigmond at column 15, lines 49-65).

As to claim 41, Zigmond and Swix disclose wherein the inserting takes place during real-time playback of the entertainment content (wherein all inserting takes place during real-time viewing and trigger detection; see Zigmond at column 15, lines 49-65).

As to claim 42, while Zigmond and Swix disclose storing entertainment content in a storage medium, they fail to specifically disclose the storage device forming a part of a television receiver device.

The examiner takes official notice that it was notoriously well known in the art at the time of invention by applicant to provide a storage medium inside a television

receiver, such as a set top box, for the typical benefit of simplifying the system through the use of a single device for both receiving and storing entertainment content.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond and Swix's system to include the storage device forming a part of a television receiver device for the typical benefit of simplifying the system through the use of a single device for both receiving and storing entertainment content.

As to claim 43, while Zigmond and Swix disclose storing entertainment content in a storage medium, they fail to specifically disclose storing the content in a set top box.

The examiner takes official notice that it was notoriously well known in the art at the time of invention by applicant to provide a storage medium inside a television receiver, such as a set top box, for the typical benefit of simplifying the system through the use of a single device for both receiving and storing entertainment content.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond and Swix's system to include storing the content in a set top box for the typical benefit of simplifying the system through the use of a single device for both receiving and storing entertainment content.

As to claim 44, Zigmond and Swix disclose wherein the entertainment content is stored in a storage device coupled to the set top box (storage medium providing recorded content to the set top for ad insertion; see Zigmond at column 14, lines 1-12).

As to claim 45, Zigmond and Swix disclose receiving a viewing history to the service provider prior to receiving the advertisement (see Swix at column 7, lines 7-11).

As to claim 46, Zigmond and Swix disclose wherein the selecting further comprises selecting the advertisement based upon information relating to the stored entertainment content being played back (see Zigmond at column 12, lines 44-51).

As to claim 47, Zigmond and Swix disclose wherein the selecting further comprises selecting the advertisement based upon a playback time (wherein time and date of playback would determine if an ad is expired; column 14, lines 1-9).

As to claim 48, Zigmond and Swix disclose wherein the selecting further comprises selecting the advertisement based upon a playback date (wherein time and date of playback would determine if an ad is expired; column 14, lines 1-9).

As to claim 49, Zigmond and Swix disclose wherein the selecting further comprises selecting the advertisement based upon information relating to a viewing history of a user (subscriber viewing selections; see Swix at column 7, lines 31-42 and column 8, lines 4-13).

As to claim 50, Zigmond and Swix disclose wherein the viewing history is transmitted from the set top box to a service provider (see Swix at column 7, lines 7-11).

As to claim 51, Zigmond and Swix disclose wherein the selecting further comprises selecting the advertisement based upon information relating to an advertising history for the user (see Zigmond at column 13, lines 40-47).

3. Claims 71-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Dedrick (5,724,521) (of record).

As to claim 71, Zigmond discloses a method of doing business, comprising:

receiving an advertisement from an advertiser (column 8, lines 22-29);

receiving a target profile defining the type of viewer that should receive the advertisement (parameters provided by the advertiser defining what type of user should receive the ad; column 11, lines 37-55);

receiving notification from a user indicative of playback of entertainment content (wherein the user must provide some command to initiate playback of the recorded content; column 14, lines 1-12), wherein the stored entertainment content is stored at a content storage device at a user site that is remotely situated from the service provider (playback from storage or a videotape at the user site; column 14, lines 1-12);

providing the user with the advertisement from the service provider (column 14, lines 66-67 and column 15, lines 1-16) based upon similarities between a user profile and the target profile (matching viewer information with selection parameters; column

11, lines 37-49), the advertisement being provided by merging the advertisement with the entertainment content at the user site (column 15, lines 52-65).

While Zigmond discloses charging an advertiser (column 8, lines 22-29), he fails to specifically disclose charging based upon the number of times the advertisement is provided to users.

In an analogous art, Dedrick discloses a system for providing advertisements to particular desired viewers (Fig. 1; column 4, lines 59-67 and column 5, lines 1-4) wherein the advertiser is charged based upon the number of times the advertisement is delivered to users (column 5, lines 26-29 and column 11, lines 16-21) for the typical benefit of ensuring that advertisers pay for every showing of their advertisements (column 11, lines 16-21).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond's system to include charging based upon the number of times the advertisement is provided to users, as taught by Dedrick, for the typical benefit of ensuring that a service provider is reimbursed by advertisers for every showing of an advertisement.

As to claim 72, Zigmond and Dedrick disclose wherein calculating the charge based upon the times the advertisement is provided to users (wherein the advertiser is charged for each time an ad is shown; see Dedrick at column 11, lines 16-21).

As to claim 73, while Zigmond and Dedrick disclose storing entertainment content in a storage medium, they fail to specifically disclose the storage device forming a part of a television receiver device.

The examiner takes official notice that it was notoriously well known in the art at the time of invention by applicant to provide a storage medium inside a television receiver, such as a set top box, for the typical benefit of simplifying the system through the use of a single device for both receiving and storing entertainment content.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond and Swix's system to include the storage device forming a part of a television receiver device for the typical benefit of simplifying the system through the use of a single device for both receiving and storing entertainment content.

As to claim 74, while Zigmond and Dedrick disclose storing entertainment content in a storage medium, they fail to specifically disclose storing the content in a set top box.

The examiner takes official notice that it was notoriously well known in the art at the time of invention by applicant to provide a storage medium inside a television receiver, such as a set top box, for the typical benefit of simplifying the system through the use of a single device for both receiving and storing entertainment content.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond and Swix's system to include storing the

content in a set top box for the typical benefit of simplifying the system through the use of a single device for both receiving and storing entertainment content.

As to claim 75, Zigmond and Dedrick disclose wherein the entertainment content is stored in a storage device coupled to the set top box (storage medium providing recorded content to the set top for ad insertion; see Zigmond at column 14, lines 1-12).

As to claim 76, Zigmond and Dedrick disclose wherein providing the advertisement is further based upon a viewing history for the user (see Zigmond at column 13, lines 7-13).

As to claim 77, Zigmond and Dedrick disclose wherein the selecting further comprises selecting the advertisement based upon information relating to the stored entertainment content being played back (see Zigmond at column 12, lines 44-51).

As to claim 78, Zigmond and Dedrick disclose wherein the selecting further comprises selecting the advertisement based upon a playback time (wherein time and date of playback would determine if an ad is expired; see Zigmond at column 14, lines 1-9).

As to claim 79, Zigmond and Dedrick disclose wherein the selecting further comprises selecting the advertisement based upon a playback date (wherein time and

date of playback would determine if an ad is expired; see Zigmond at column 14, lines 1-9).

As to claim 80, Zigmond and Dedrick disclose wherein the selecting further comprises selecting the advertisement based upon information relating to an advertising history for the user (see Zigmond at column 13, lines 40-47).

4. Claims 26, 52 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond and Swix as applied to claims 10, 36 and 59 above and further in view of Gill et al. (Gill) (US2002/0083451) (of record).

As to claims 26, 52 and 70, while Zigmond and Swix disclose selecting the advertisement based upon user profile information relating to a user, they fail to specifically disclose a profile relating to a plurality of users.

In an analogous art, Gill discloses a cable television system (paragraph 35) utilizing a subscriber profile to provide targeted advertising (paragraph 39) wherein the subscriber profile relates to a plurality of users (plural subscribers in a household; paragraph 40) for the typical benefit of providing a single profile which can characterize the interests of multiple users in a household (paragraph 40).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond and Swix's system to include the use of a profile relating to a plurality of users, as taught by Gill, for the typical benefit of utilizing a

single profile which can characterize the interests of every cable television user in a household receiving targeted advertising.

5. Claim 81 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond and Dedrick as applied to claim 71 above and further in view of Gill.

As to claims 26, 52 and 70, while Zigmond and Swix disclose selecting the advertisement based upon user profile information relating to a user, they fail to specifically disclose a profile relating to a plurality of users.

In an analogous art, Gill discloses a cable television system (paragraph 35) utilizing a subscriber profile to provide targeted advertising (paragraph 39) wherein the subscriber profile relates to a plurality of users (plural subscribers in a household; paragraph 40) for the typical benefit of providing a single profile which can characterize the interests of multiple users in a household (paragraph 40).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond and Swix's system to include the use of a profile relating to a plurality of users, as taught by Gill, for the typical benefit of utilizing a single profile which can characterize the interests of every cable television user in a household receiving targeted advertising.

***Response to Arguments***

6. Applicant's arguments to the claims have been considered but are moot in view of the new ground(s) of rejection.

7. On pages 16 and 17, applicant argues that claim 8, among others, as originally filed contained features similar to those of the amended claims and therefore that this action cannot be made final as the claimed features were not properly considered.

In response, applicant is directed to the fact that claim 8 previously stated that "the entertainment content is stored in a storage device coupled to a set-top box." There was no previous indication of when this storage took place, which was indicated in the previous action as occurring after a user selected and received VOD content.

The currently amended claims are further limiting in that the content must be stored in the user's set top box prior to a user notifying the service provider of playback. This further limitation was not previously present and considered and is resulting in the new grounds of rejection.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (703) 305-8722. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Sheleheda
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JS

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